

rather lengthy prosecution of this application. In particular, Applicants discussed how the previous Examiner had repeatedly acknowledged that the present claims would be allowable over the very same prior art references relied upon in the outstanding Final Office Action. Examiner's Bui and Pwu, however, continue to maintain that the outstanding grounds for rejection are sufficient to render the pending claims 99-114 and 166-212 unpatentable without providing any coherent explanation for why the previous Examiner's decision was incorrect. Accordingly, Applicants respectfully request that the new Examiner reconsider and withdraw the outstanding grounds for rejection for the following reasons.

II. The Outstanding Grounds For Rejection

As set forth on pages 2-4 of the Final Office Action, the Examiner rejected claims 99-108, 166-170, 180, 185-206, and 212 under 35 U.S.C. § 103(a) as being unpatentable over Acebo et al. (U.S. Patent No. 6,023,679). The Examiner also rejected claims 109-112, 171-179, 181-184, and 207-211 under 35 U.S.C. § 103(a) as being unpatentable over Acebo et al. in view of Shoolery et al. (U.S. Patent No. 5,570,283) for the reasons discussed on pages 4-5 of the Office Action. The Examiner further rejected claims 113-114 under 35 U.S.C. § 103(a) as being unpatentable over Acebo et al. in view of Shoolery et al., and further in view of Kahl et al. (U.S. Patent No. 5,936,625), as discussed on page 6 of the Office Action.

III. Independent Claims 99 and 198

As repeatedly discussed throughout the lengthy prosecution of this application, Acebo et al., Shoolery et al., and Kahl et al. simply cannot render the claimed invention unpatentable because they fail to disclose or suggest each and every one of the

claimed features, as required by 35 U.S.C. § 103(a). For example, independent claim 99 recites a method that includes, among other things,

storing in a database a set of frequent trip records, each frequent trip record associated with a traveler and reflecting a travel itinerary;
receiving selection information reflecting a selected one of the frequent trip records to form a trip request; [and]
prompting a user to indicate at least one new travel date associated with the trip request regardless of whether the selected frequent trip record has any associated travel dates,

(claim 99, ll. 3-9). Moreover, independent claim 198 recites another combination of features that includes:

storing in a database a set of frequent trip records, each frequent trip record including a travel itinerary associated with a traveler;
displaying a menu selected from the stored set of frequent trip records;
prompting a user to select one of the frequent trip records from the displayed menu to form a new travel reservation;
prompting the user to indicate a new trip travel date for the new travel reservation regardless of whether the selected frequent trip record includes a travel date

(claim 198, ll. 3-10). At the very least, Acebo et al., Shoolery et al., and Kahl et al. all fail to disclose or suggest any of these exemplary features recited in claims 99 and 198.

IV. The Examiner Has Failed To Establish A Prima Facie Case of Obviousness

To establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), the Examiner must demonstrate that (1) Acebo et al., as proposed to be repeatedly modified by the teachings of Shoolery et al. and Kahl et al., discloses or suggests each and every feature recited in the claims, (2) there is a reasonable probability of success in making the Examiner's imagined modifications; and (3) there is, in fact, motivation within either Acebo et al., Shoolery et al., and Kahl et al., or the knowledge generally available to one of ordinary skill in the art, to make the Examiner's proposed modifications so as to result in the claimed invention. See M.P.E.P. § 2143 (7th ed.

1998). It bears emphasizing that each of these requirements must be found in the prior art — not based on Applicants' own disclosure. See *id.*

Viewed against this standard, each of the Examiner's factual conclusions must be supported by "substantial evidence" in the documentary record. See *In re Lee*, 61 U.S.P.Q.2d 1430, 1435 (Fed. Cir. 2002). The Examiner has the burden of documenting all findings of fact necessary to support a conclusion of anticipation or obviousness "less the 'haze of so-called expertise' acquire insulation from accountability." *Id.* To satisfy this burden, the Examiner must specifically identify where support is found within the prior art to meet the requirements of 35 U.S.C. § 103(b).

In this case, however, the Examiner has not identified where the Acebo et al., Shoolery et al., and Kahl et al. patents teach or suggest each and every one of the features recited in the claims. Nor has the Examiner even attempted to show the existence of any reasonable probability of success in modifying Acebo et al. with the teachings of Shoolery et al. and Kahl et al. in the manner imagined by the Examiner. Finally, the Examiner has not identified where any motivation exists in either the teachings of Acebo et al., Shoolery et al., and Kahl et al. themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the Acebo et al. system in a manner proposed by the Examiner.

V. The Acebo et. al. Patent Cannot Render Claims 99 and 198 Obvious

As acknowledged by the Examiner, Acebo et al. discloses a system for transmitting data from a passenger name record ("PNR") in a computer reservation system ("CRS") to a travel agent's locally operated computer system. The Acebo et al. system is directed to a "a method for automatically generating pre-ticketed booked

travel reservation information" that includes accessing "traveler identification information, which includes name, address, and billing information . . . from an existing customer profile." Col. 4, ll. 37-46. There is, however, no disclosure within Acebo et al. of creating a new travel reservation based on information reflecting frequent trips. The Acebo et al. system does not store a set of frequent trip records, receive selection information reflecting a selected one of the frequent trip records, and prompt a user to supply a new travel date associated with a trip request regardless of whether the selected frequent trip record already has any associated travel dates, as recited by independent claims 99 and 198.

As shown in Figs. 3 and 4, Acebo et al. specifically discloses the use of a PNR that includes date information (i.e., "O2 MAY 90") associated with the travel arrangement. This date information is automatically supplied in the PNR of Acebo et al. to allow a travel agent to track and analyze pre-ticketed and booked travel information. One skilled in the art would thus readily recognize that Acebo et al. actually teaches away from the claimed invention. Since associated travel dates are automatically supplied in the Acebo et al. PNR, a skilled artisan would readily recognize that the Acebo et al. system, the Examiner's proposed step of prompting a user to supply a new travel date to the Acebo et al. system would amount to a superfluous and unnecessary act. In fact, the Examiner's proposed modification would prevent the Acebo et al. system from fulfilling one its intended purposes -- tracking and analyzing pre-ticketed travel reservations. By automatically supplying date information, the Acebo et al. system also removes any need for prompting a user to supply this information in the manner recited in claims 99 and 198, as the Examiner proposes. Accordingly, Acebo et

al. not only fails to disclose or suggest each and every element recited in independent claims 99 and 198, but also teaches away from the claimed invention.

VI. The Examiner's Sole Argument That The Acebo et al. Patent Is Capable of Being Modified To Result In The Claimed Invention Cannot Satisfy The Requirements of 35 U.S.C. § 103

During the interview of June 19, 2003, the Examiner's sole argument was that the Acebo et al. system is "capable of" performing the features recited in the claims. Specifically, Examiner Bui argued that a completed PNR in the Acebo et al. system, which already includes the date of the completed trip, somehow "can" be modified to meet the claim limitations by inserting a date for use in creating a new travel reservation based on a selected one of the stored frequent trip records. Putting aside for the moment the fact that Acebo et al. does not even disclose the completion of a new travel reservation based on such a stored frequent trip record, this imagined modification is not enough to render independent claims 99 and 198 unpatentable under 35 U.S.C. § 103. To the contrary, in making this argument, the Examiner has ignored the provisions of the Manual of Patent Examining Procedure ("MPEP"). As discussed above, Acebo et al. fails to provide any disclosure whatsoever of completing a new travel reservation by storing a set of frequent trip records, receiving selection information based on a selected one of the frequent trip records, and prompting a user to supply a new travel date regardless of whether the selected frequent trip record already has any associated travel dates, as recited in independent claims 99 and 198. Even if Acebo et al. could be read to be capable of being modified in the manner contemplated by the Examiner, which it could not, absent Applicants' disclosure, the mere fact that a reference can be modified in a manner imagined only by the Examiner does not render the resultant

modification either obvious, or an anticipating prior art reference. The MPEP clearly states that the "mere fact that references *can be* . . . modified is not sufficient to establish *prima facie* obviousness." M.P.E.P. § 2143.01 (7th ed. 1998).

There is simply no motivation for modifying the Acebo et al. system in the manner suggested by the Examiner. One skilled in the art at the time of the invention would not even consider modifying the Acebo et al. system, such as by removing the step of automatically supplying date information to somehow complete a new travel reservation based on, among other things, a stored frequent trip record, as the Examiner proposes. By way of example, Acebo et al. explicitly teaches away from the claimed invention by automatically providing new travel dates – rather than prompting a user to supply a new travel date associated with a trip request regardless of whether the selected frequent trip record has any associated travel dates, as required by independent claims 99 and 198. Indeed, the Examiner's unsubstantiated modification would unnecessarily change the principles of operation of the Acebo et al. system. The MPEP specifically states that if the "proposed modification would . . . change a principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious." M.P.E.P. § 2143.01 at 112-13 (7th ed. 1998). There is further no motivation generally known within the art to modify the Acebo et al. system to operate in the manner imagined by the Examiner.

The Examiner has thus failed to satisfy his burden of supporting his factual conclusions by "substantial evidence" in the record, as required by the MPEP and Federal Circuit jurisprudence. See *In re Lee*, 61 U.S.P.Q.2d at 1435. There is no

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teaching present with the Acebo et al. system that could motivate one skilled in the art to delete the explicitly taught step of automatically supplying date information, and, instead, prompt a user to supply new date information, as the Examiner appears to suggest. Therefore, it is only through hindsight and conjecture afforded by Applicants' own disclosure that the Examiner can even assert that Acebo et al. somehow suggests each and every element of the claimed invention. Such hindsight determinations are impermissible under 35 U.S.C. § 103.

VII. The Outstanding Final Office Action Fails To Address Each of The Features Recited In Independent Claim 198

As set forth on pages 2-4 of the Final Office Action, the Examiner rejected claims 99-108, 166-170, 180, 185-206, and 212 under 35 U.S.C. § 103(a) as being unpatentable over Acebo et al. (U.S. Patent No. 6,023,679). The Final Office Action, however, does not address each and every one of the features recited in independent claim 198. For example, there is no discussion whatsoever within the Office Action of "displaying a menu selected from the stored set of frequent trip records," as recited in independent claim 198. As discussed during the interview on June 19, 2003, the Acebo et al. provides absolutely no disclosure of this feature of independent claim 198. The MPEP specifically states that "[a]ll words in a claim must be considered" in determining patentability." M.P.E.P. § 2143.01 at 112-13 (8th Ed., Aug. 2001). Moreover, applicable Federal Circuit precedent specifically requires that the Examiner support each ground for rejection by "substantial evidence" in the documentary record. *See In re Lee*, 61 U.S.P.Q.2d at 1435. There is no evidence in this record that supports the outstanding grounds for rejection of each and every one of the claim features. Accordingly, Applicants respectfully request that the Examiner withdraw the outstanding grounds for

rejection, and provide a suitable indication of allowability for each of the claims are not present in the Acebo et al. patent without any further delay.

VIII. The Secondary References Cannot Render Claims 99 and 198 Obvious

Turning to the secondary references, Shoolery et al. fails to remedy the deficiencies of Acebo et al. For example, the Examiner relies upon Shoolery et al. to teach the existence of a “means for determining whether all components of the new travel reservation comply with the pre-determined policies or agreements.” (Office Action at 45.) This feature has nothing to do with the failure of Acebo et al. to, among other things, prompt a user to supply a new travel date associated with a trip request regardless of whether the selected frequent trip record has any associated travel dates, as required by independent claims 99 and 198. Indeed, the claimed invention is directed to a method for creating a new travel reservation based on information reflecting frequent trips. Shoolery et al. is devoid of any suggestion of the steps of storing a set of frequent trip records, and receiving selection information reflecting a selected one of the frequent trip records, as recited more particularly in independent claims 99 and 198. Nor does Shoolery et al. disclose the step of prompting a user to indicate a new travel date associated with a trip request regardless of whether the selected frequent trip record has any associated travel dates, as also recited in independent claims 99 and 198.

As discussed in the Amendment dated April 15, 2002, the Shoolery et al. system only allows a travel agent to re-enter travel time and date information to complete the process of booking a single travel reservation. See Col. 7, ll. 16-20. In the practice of the Shoolery et al. system, a travel agent completes the booking process without the

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use of a set of frequent trip records, as further recited in independent claims 99 and 198. In the Shoolery et al. system, there is further no "selected frequent trip record," let alone the need to indicate a new travel date associated with a new trip request even when such a selected frequent trip record already includes an associated travel date, as further recited in independent claims 99 and 198. Additionally, Shoolery et al. does not provide any reason for why one skilled in the art would modify the data tracking system of Acebo et al. by adding the extra step of prompting a user to indicate a new travel date, as suggested by the Examiner. One having ordinary skill in the art would readily recognize that Shoolery et al. simply does not provide any suggestion or motivation for the Examiner's proposed modification of Acebo et al. Consequently, modifying the Acebo et al. system with the teachings of Shoolery et al. would only result in a system that cannot perform the claimed feature.

In addition, Kahl et al. also fails to overcome the shortcomings of Acebo et al. and Shoolery et al. For example, the Examiner relies upon Kahl et al. solely to allegedly teach the existence of a calendar having icons, (see Office Action at 6). As a result, each of the secondary references unquestionably fails to remedy the deficiencies of Acebo et al. For at least these reasons, Acebo et al., Shoolery et al., and Kahl et al. all fail to disclose or render obvious each and every element recited in independent claims 99 and 198.

IX. The Dependent Claims

In addition, dependent claims 100-114, 166-197, and 199-212 recite additional limitations that are neither disclosed nor suggested by each of the applied references, taken either alone or in combination. Thus, each of the dependent claims is allowable

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for at least the same reasons discussed above with respect to independent claims 99 and 198.

In fact, the outstanding Final Office Action does not even address the features recited in many of the dependent claims. By way of example, dependent claims 168 and 170 call for, among other things "providing the particular traveler with an opportunity to cancel the new travel reservation within a predetermined period of time." Dependent claim 180 calls for "automatically forwarding the new travel reservation to a travel agency for post reservation processing." Dependent claim 186 states that "wherein the at least one new travel date comprises a beginning travel date on which travel for the new travel reservation will begin." Claim 187 further calls for "automatically identifying an ending date on which travel for the new travel reservation will end." In addition, dependent claim 188 provides that "wherein the step of automatically identifying the ending date is based solely on the travel itinerary associated with the selected one of the frequent trip records and the beginning travel date indicated by the user." Similarly, dependent claim 189 calls for "automatically identifying a travel duration for the new travel reservation" and dependent claim 194 states that "wherein the transmitted aspects of the trip request comprise a travel duration for the new travel reservation." Finally, dependent claim 195 states that "wherein the travel duration for the new travel reservation is automatically identified based solely on the travel itinerary associated with the selected one of the frequent trip records." There is neither any suggestion within the prior art, nor any discussion in the outstanding Final Office Action of these claim features. Accordingly, Applicants respectfully request that the Examiner reevaluate each of the dependent claims, and withdraw the outstanding grounds for rejection for

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each of the features recited in the dependent claims that cannot be adequately identified in the prior art to justify the outstanding grounds for rejection.

X. Conclusion

In view of the foregoing remarks, Applicants respectfully request reconsideration of this application and the timely allowance of all the pending claims 99-114 and 166-212. Additionally, the Examiner is invited to telephone the undersigned Applicants' representatives at (202) 408-6052 if this would help to expedite the prosecution of this application.

Please grant any extension of time to the extent required to enter this response and charge any fees required to our Deposit Account No. 06-0916.

Respectfully submitted,

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